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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/850,338	05/07/2001	Marko Schuba	52275-00003USPX	2528

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EXAMINER

DINH, MINH

ART UNIT

PAPER NUMBER

2132

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/850,338

Applicant(s)

SCHUBA ET AL.

Examiner

Minh Dinh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/7/2001.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

1. Claims 1-26 have been examined.

Claim Objections

2. Claims 4-13, 16, 20-24 and 26 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim or a claim refers to two set of claims to different features. See MPEP § 608.01(n). The claims have been treated to the following extent: claims 4-6 and 8-10 depends from claim 3; claim 7 depends from claim 6; claims 11-13 depends from claim 10; claim 16 is interpreted as depending on claims 14 or 15 wherein the server performs at least one step according to the method of claim 1; claims 20-21 and 23-24 depend from claim 19; claim 22 depends from claim 21; claim 26 depends from claim 25 wherein the program unit performs at least one step of a method according to claim 2.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 25-26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. It is not tangibly embodied as it is only software per se. It is suggested that the claimed subject matter "computer program unit

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..." should be changed to "a computer program unit stored on a computer-readable medium ...".

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 17-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 17 recites the broad recitation "user equipment for a communication system", and the claim also recites "especially for a mobile communication system" which is the narrower statement

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of the range/limitation. Claims that are not specifically addressed are rejected by virtue of their dependencies. Prior art rejection for claims 17-24 are based on the broad recitation "user equipment for a communication system".

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-9 and 14-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Elgamal (5,671,279).

a. Regarding claims 1-2, which are representative of claims 17 and 25-26, Elgamal discloses a method for authorizing transactions, wherein a user equipment (fig. 1, element 16) receives an authorization request (fig. 1) with a hash of the purchase order (col. 9, lines 43-48), which meets the limitation of an identifier of a transaction (specification p. 12, lines 1-2) and replies to the request with an authorization response (fig. 2), said method comprising the steps of:

receiving the authorization request (fig. 1; col. 9, lines 55-60; col. 25, lines 44-57),

determining the purchase order, which meets the limitation of an indication for the authorization request (col. 26, lines 13-21),

output of the indication by the user equipment (UE) (col. 26, lines 13-21 and 64-66),

waiting for an input to approve or disapprove the authorization request (col. 25, lines 44-57; col. 26, lines 13-21 and 64-66),

signing the identifier (H) (col. 9, line 60 – col. 10, line 12; col. 26, lines 13-21 and 64-66),

sending the authorization response according to the input, wherein an approving authorization response comprises the signed identifier (H) (fig. 2; col. 9, line 60 – col. 10, line 12).

b. Regarding claims 3 and 18, Elgamal further discloses that a check is performed whether the authorization request comprises a string (T) and the indication is the detected string (T) (col. 25, lines 44-51; col. 26, lines 13-21 and 64-65).

c. Regarding claims 4 and 19, Elgamal further discloses that the displayed indication is included in the authorization response (col. 9, lines 61-67).

d. Regarding claims 5 and 20, Elgamal further discloses that a check is performed whether a connection is classified as safe and the indication is selected according to the check (col. 9, lines 4-7).

e. Regarding claims 6 and 21, Elgamal further discloses that the authorization request comprises a signature of the sender and a check of the sender signature is performed (col. 9, line 60; col. 28, lines 4-8).

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- f. Regarding claims 7 and 22, Elgamal further discloses that the authorization request comprises a signature of the sender and a check of the sender signature is performed (col. 9, line 60; col. 28, lines 4-8).
- g. Regarding claims 8-9 and 23-24, Elgamal further discloses using a timestamp as an additional parameter in any type of message (col. 9, line 60; col. 28, lines 4-8).
- h. Regarding claim 14, Elgamal discloses a server for processing authorization procedures in a communication system with an interface to exchange messages with user equipment of the communication system, wherein the server has a processing system adapted to send an authorization request for a content which is to be authorized to the user equipment and to receive an authorization response from the user equipment (figures 1 and 2), characterized in that
- the processing system determines an identifier for the content and includes the identifier into the authorization request (col. 9, lines 43-44 and 55-60),
- the processing system determines an indication for the content and includes the indication into the authorization request (col. 9, lines 55-60) and
- the server checks the authorization response for the identifier signed by the user equipment (col. 9, lines 61-64; col. 28, line 65 – col. 29, line 2).
- i. Regarding claim 15, Elgamal further discloses that the server comprises an interface to receive messages from a further entity and the processing system is adapted to extract the content for authorization from a message received from the further network entity and to send a reply to the further network entity, wherein the reply is determined by the authorization response (fig. 2, col. 29, lines 36-38).

j. Regarding claim 16, Elgamal further discloses that the server receives and verifies an authorization request from the customer and sends an authorization response to the customer (fig. 2; col. 24, lines 29-36; col. 25, lines 15-27).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elgamal as applied to claim 3 above, and further in view of "WMLScript Crypto Library". Elgamal does not disclose that the authorization request is sent by a server (MS) after reception of a message from a further entity and the server forwards an approval of the identifier and the indication to the further entity. The "WMLScript Crypto Library" reference discloses that an authorization request including an identifier is sent by a proxy server to a mobile device after the proxy server receives a message from a further entity and the proxy server forwards an approval of the identifier and the indication to the further entity (p. 14, section 6.1, Usage with signText; Section 6.2, Hash Calculation and Relationship to PKCS#7 SignedData, "When a mobile device ... not supporting WAP signed content type"; p. 15, "A proxy server MAY construct ... WML or WMLScript"). It would have been obvious to one of ordinary skill in the art at the time

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the invention was made to modify the Elgamal method such that the authorization request is sent by a server (MS) after reception of a message from a further entity and the server forwards an approval of the identifier and the indication to the further entity, as taught in the "WMLScript Crypto Library" reference. The motivation for doing so would have been to enable end-to-end signed content verification with servers not supporting the WAP signed content type.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Gabber et al (6,742,125) discloses a distributed protocol for secure communication of commercial transactions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Dinh whose telephone number is 703-306-5617. The examiner can normally be reached on Mon - Fri: 9:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 703-305-1830. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

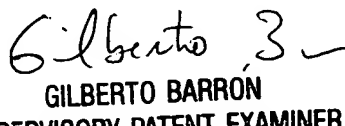
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MD

Minh Dinh
Examiner
Art Unit 2132

MD
9/29/04


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